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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

26416/04844

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on **September 7, 2005**

Signature

Typed or printed name

Debra L. Hale

Application Number

09/558,458

Filed

April 25, 2000

First Named Inventor

David Vincent Zyzak et al.

Art Unit

1761

Examiner

Leslis A. Wong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number **50,627**☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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September 7, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of **1** forms are submitted.

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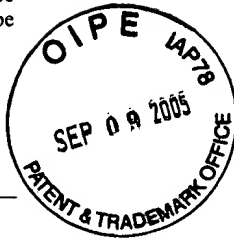
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/558,458 Confirmation No. 9230
Applicant : David Vincent Zyzak, *et al.*
Filed : April 25, 2000
TC/A.U. : 1761
Examiner : Leslie A. Wong
Docket No. : 26416/04844
Customer No. : 24024

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR REQUESTING PRE-APPEAL REVIEW

Sir:

Applicants request consideration of these reason for requesting Pre-Appeal Review.

Reasons begin on page 2 of this paper.

Claims 1-9 12-14 and 21-28 are pending in this application; claims 21-28 are withdrawn from consideration; claims 1-9 and 12-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Stolz (US Pat. No. 5,650,185, hereinafter referred to as “Stolz”) in view of Fennema (Food Chemistry, Third Ed., Marcel Dekker, Inc., New York: 1996, hereinafter referred to as “Fennema”) and Patel (US Pat. No. 5,153,011, hereinafter referred to as “Patel”). For the reasons set forth herein, Applicants respectfully request reconsideration of claims 1-9 and 12-14.

The references cited do not teach or suggest a flavor enhancing oil comprising a liquid edible oil, 1.5 to 2.2% by weight of silicon dioxide, and a flavor-enhancing amount of at least one water soluble particulate flavor enhancer, wherein the water-soluble particulate flavor enhancer is dispersed throughout the edible oil.

No combination of the references teaches or suggests a suspension of water-soluble particulate flavor enhancers in an edible oil. No combination of the references teach or suggests a method by which a stable composition comprising water-soluble particulate flavor enhancers dispersed in an edible oil may be made. Stolz teaches the use of oil-based, i.e., oil-soluble, flavorants in oil. These oil-soluble **flavorants** differ from Applicants’ water-soluble particulate **flavor enhancers** in two distinct ways. First, every flavorant mentioned throughout Stolz is oil-based, and therefore, miscible in the oils to which they are added. There are no special considerations in adding these oil-based flavorants to oil. When mixed with the oil, these oil-based flavorants dissolve in the oil and remain dissolved in the oil. (See Applicants’ response of 12/12/02, pages 2-3.)

Second, Applicants’ claimed invention differs from that of Stolz in that the claimed invention is directed to flavor enhancers, which have little or no flavor on their own, but actually act to enhance the flavors of the foods to which they are added. This effect is even further enhanced by heating the flavor enhancers to a temperature high enough that they decompose. However, the decomposition temperature is higher than the boiling point of water. Dissolving the flavor enhancers in water, therefore, limits their potential. Moreover, because these flavor enhancers are insoluble in oil, there has been no way to uniformly deliver these flavor enhancers in an oil medium, wherein the flavor enhancers could be heated to a high enough temperature for decomposition and enhancement of their flavor enhancing properties.

Clearly this is different from the oils containing oil-based flavorants of Stolz, which impart a specific flavor, *i.e.*, butter flavor, lemon flavor, tuna flavor and so on, to the oil and subsequently impart that particular flavor to the food on which they are applied.

The PTO asserts that because flavor potentiators are well-known, citing Fenemma, it would be obvious to merely substitute a water-soluble particulate flavor enhancer for an oil-based flavorant in an edible oil. As Applicants have argued, while Fenemma does list flavor enhancers, no combination of Stolz and Fenemma, or Stolz, Fenemma and Patel teach or suggest how these water-soluble particulate flavor enhancers may be dispersed throughout an edible oil, as claimed.

The addition of oil-based flavorants is very different from the claimed suspension of a water-soluble particulate in an oil. The oil-based flavorants of Stolz are easily delivered, along with the oil, to whatever they are used to flavor. These flavorants are also delivered evenly since they are actually dissolved in the oil. Because these oil-based flavorants are dissolved in the oil, the first time the oil is delivered it will have the same amount of flavorant delivered per amount of oil as the second time the oil is delivered, as the third time the oil is delivered, and so on. When a water-soluble, *i.e.* oil-insoluble, particulate is added to the oil, it does not dissolve, but rather, remains separate from the oil, and merely settles. Because the water-soluble flavor enhancer settles out, it is not delivered with the oil, and therefore does not impart flavor enhancement when the oil is used. This is one of the problems that Applicants have solved.

The PTO cites Patel to show that silicon dioxide is well-known in the art as a thickener/stabilizer. Patel teaches the use of silicon dioxide as a thickener for a chewing gum flavor composition comprising silicon dioxide. Patel specifically teaches the addition of silicon dioxide to a gum base flavor mixture to thicken and stabilize that mixture just prior to drying it. Specifically, the silicon dioxide is added to the flavor/oil mixture, but only after the flavor/oil mixture is combined with an aqueous starch solution to form an emulsion. The silicon dioxide is used to stabilize that oil/water emulsion as it is formed. The silicon dioxide is used to stabilize the oil/water emulsion for the short period of time between when the silicon dioxide is added and when the emulsion is spray dried.

Reasons for Requesting Pre-Appeal Review

Just because silicone dioxide may be used to stabilize a water/oil emulsion for a short period of time just prior to drying that emulsion does not lead to the conclusion that silicon dioxide may be added to an oil such that a final product comprising the oil, silicon dioxide, and oil-insoluble flavor enhancer is a stable finished product where the solids do not separate from the liquid phase. In fact, as taught by Applicants in their specification, merely combining the oil, silicon dioxide and flavor enhancer will not produce a stable product wherein the solids do not separate from the oil phase. Rather, Applicants make clear that the processing steps and the order in which the silica are added is critical to making a stable product. (*See*, specification, page 5, lines 31-33.) No combination of the references cited teaches or suggests the critical order needed to form Applicants claimed oil composition.

Because no combination of Stolz, Fenemma, and Patel teach or suggest Applicants' claimed invention, Applicants respectfully submit that claims 1-9 and 12-14 are patentable over the cited prior art. A decision to that effect is respectfully requested.